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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,647	09/24/2001	Jean-Jacques Claisse	CLAISSE=2	6513

7590 03/06/2003

BROWDY AND NEIMARK, P.L.L.C.  
624 Ninth Street, N.W.  
Washington, DC 20001

EXAMINER

NORDMEYER, PATRICIA L

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 03/06/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/960,647	Applicant(s) CLAISSE ET AL.	
Examiner Patricia L. Nordmeyer	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All    b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-9.                      6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of claims 18 – 28 in Paper No. 11 is acknowledged.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Gothberg (USPN 4,391,426).

Gothberg discloses a plastic article (Column 1, lines 7 – 8) having a weakened section containing a longitudinal collection of holes (Figures 1 and 3, #13) in an oblong shape (Column 2, lines 12 – 13). The plastic article is a support strip for conduits and cables (Column 1, lines 27 – 30) that has a covering (Column 2, lines 28 – 32 and Figures 2 and 4).

Regarding the plastics material section being made by the method of producing a part, forming an opening, heating the part with a probe and using a punch to modify the part to form a hole or hole precursor in claim 18, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations of producing a part, forming, heating and punching are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

3. Claims 18 and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by Thorp et al. (USPN 5,914,665).

Thorp et al. discloses a plastic cover (Figure 1, #17 and Column 3, lines 37 – 39) having

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a weakened sections that form a longitudinal collection of blind holes covered with a continuous web of plastic that are punched out when the openings are needed (Figure 1, #131, 134 and 136 and Column 4, lines 30 – 37).

Regarding the plastics material section being made by the method of producing a part, forming an opening, heating the part with a probe and using a punch to modify the part to form a hole or hole precursor in claim 18, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations of producing a part, forming, heating and punching are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

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4. Claims 18 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogasawara et al. (USPN 6,089,723).

Ogasawara et al. discloses a plastic cover (Column 1, line 31) having a weakened sections that form a longitudinal collection of through holes with a peripheral web of plastic used for the placement of screws (Figure 3, #15).

Regarding the plastics material section being made by the method of producing a part, forming an opening, heating the part with a probe and using a punch to modify the part to form a hole or hole precursor in claim 18, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations of producing a part, forming, heating and punching are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459

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F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

5. Claims 18, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaminstein (USPN 4,457,964).

Ogasawara et al. discloses a plastic article (Figures 1 – 3 and Column 4, line 63 to Column 5, line 8) having weakened sections that have a contour formed from a longitudinal collection of through holes (Column 4, lines 58 – 60). The through holes have an oblong shape (Column 4, lines 60 – 62).

Regarding the plastics material section being made by the method of producing a part, forming an opening, heating the part with a probe and using a punch to modify the part to form a hole or hole precursor in claim 18, the determination of patentability for a product-by-process claim is based on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 946, 966 (Fed. Cir. 1985) and MPEP §2113. In this case, the limitations of producing a part, forming, heating and punching are methods of production and therefore do not determine the patentability of the product itself. Process limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. Further, when the prior art discloses a product which reasonably appears to be either

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identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the Applicant to present evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F.2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F.2d 742, 180 USPQ 324 (CCPA 1974).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thorp et al. (USPN 5,914,665).

Thorp et al. discloses a plastic cover (Figure 1, #17 and Column 3, lines 37 – 39) having a weakened sections that form a longitudinal collection of blind holes covered with a continuous web of plastic that are punched out when the openings are needed (Figure 1, #131, 134 and 136 and Column 4, lines 30 – 37). However, Thorp et al. fail to disclose the weakened area being an oblong section.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen



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improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the openings in the plastic article to an oblong shape. One skilled in the art would have been motivated to do so in order to allow different conduits to enter into the box and have a tight fit between the two articles.

8. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogasawara et al. (USPN 6,089,723).

Ogasawara et al. discloses a plastic cover (Column 1, line 31) having a weakened sections that form a longitudinal collection of through holes with a peripheral web of plastic used for the placement of screws (Figure 3, #15). However, Ogasawara et al. fail to disclose the weakened area being an oblong section.

It is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen

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improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947).

Also, see *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966) (the court held that the configuration of the claimed disposable plastic nursing container was a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed container was significant.) In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change the shape of the openings in the plastic article to an oblong shape. One skilled in the art would have been motivated to do so in order to allow different types of screws and bolts to hold the two articles together.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (703) 306-5480. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

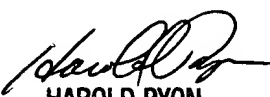
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

February 27, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

3/4/03